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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,590	06/16/2006	Sei-ichi Onoue	UNU94.001APC	8151
20995 7590 07/15/2009 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER				
REDDY, KARUNA P				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
07/15/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
eOAPilot@kmob.com

Office Action Summary

Application No.

10/596,590

Applicant(s)

ONOU ET AL.

Examiner

KARUNA P. REDDY

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 21-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to the amendment filed 5/12/2009. Claims 5-20 are cancelled and claim 24 is amended. Accordingly, claims 1-4, 21-26 are currently pending in the application.

With regard to amendment to claim 24 it is noted that said amendment is cosmetic in that a redundant period has been deleted. Given that and given that the grounds of rejection remain unchanged from that set forth in the preceding office action, it is proper to make this action final.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

3. Claims 1, 4 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Storrow et al (US 3,069, 375) in view of Swarup et al (US 5, 506, 325).

The rejection is adequately set forth in paragraph 4 of office action mailed 2/12/2009 and incorporated here by reference.

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Storrow et al (US 3,069, 375) in view of Swarup et al (US 5, 506, 325) as applied to claim 1 above, and further in view of Kano (US 5, 891, 948).

The rejection is adequately set forth in paragraph 5 of office action mailed 2/12/2009 and incorporated here by reference.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Storrow et al (US 3,069, 375) in view of Swarup et al (US 5, 506, 325) as applied to claim 1 above, and further in view of Kano (US 5, 891, 948) and Gagliardi et al (US 5, 961, 674).

The rejection is adequately set forth in paragraph 6 of office action mailed 2/12/2009 and incorporated here by reference.

6. Claims 1 and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Storrow et al (US 3,069, 375) in view of Inagaki et al (US 4, 427, 823)

The rejection is adequately set forth in paragraph 7 of office action mailed 2/12/2009 and incorporated here by reference.

7. Claims 1, 4, 21-22 and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weinberger et al (US 6, 008, 291) and Swarup et al (US 5, 506, 325).

The rejection is adequately set forth in paragraph 8 of office action mailed 2/12/2009 and incorporated here by reference.

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weinberger et al (US 6, 008, 291) and Swarup et al (US 5, 506, 325) as applied to claim 1 above, and further in view of Kano (US 5, 891, 948).

The rejection is adequately set forth in paragraph 9 of office action mailed 2/12/2009 and incorporated here by reference.

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weinberger et al (US 6, 008, 291) and Swarup et al (US 5, 506, 325) as applied to claim 1 above, and further in view of Kano (US 5, 891, 948) and Gagliardi et al (US 5, 961, 674).

The rejection is adequately set forth in paragraph 10 of office action mailed 2/12/2009 and incorporated here by reference.

10. Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weinberger et al (US 6, 008, 291) and Swarup et al (US 5, 506, 325) as applied to claim 1 above, and further in view of Inagaki et al (US 4, 427, 823).

The rejection is adequately set forth in paragraph 11 of office action mailed 2/12/2009 and incorporated here by reference.

Response to Arguments

11. Applicant's arguments, filed 5/12/2009, with respect to objection of claim 24; and rejection of claim 20 under 35 U.S.C. 103(a) as being unpatentable over Weinberger et al (US 6, 008, 291) and Swarup et al (US 5, 506, 325), have been fully considered and are persuasive. The objection of claim 24; and rejection of claim 20 under 35 U.S.C. 103(a) as being unpatentable over Weinberger et al (US 6, 008, 291) and Swarup et al (US 5, 506, 325), has been withdrawn either in view of the amendment or cancellation of claims.
12. Applicant's arguments filed 5/12/2009 have been fully considered but they are not persuasive. Specifically, applicant argues that (A) data in the declaration submitted

under 37 C.F.R. § 1.132 shows that claimed pH range of 5 to 7.8 for neutral silica sol leads to superior properties with respect to efflorescence resistance test and anti-staining properties, when compared to material at a pH of 8.0; (B) Weinberg et al recite a pH of from about 7.0 to 14.0 and is silent about electrical conductivity. The showing of unexpected results for a pH of 7.8 (which is within the claimed range) rebuts any prima facie case of obviousness.

With respect to (A), examiner agrees with the showing of unexpected results for neutral silica sol of present claims with the recited pH range of 5.0 to 7.8. However, the showing of unexpected results is restricted to using silica sol (10 parts by weight of solids content) relative to 100 parts by weight of solid content of resin emulsion and is not commensurate with scope of present claims.

With respect to (B), showing of unexpected results is not commensurate with scope of present claims, because the present claims are directed to a composition comprising silica sol with a pH of from 5.0 to 7.8, while the showing of unexpected results is restricted to a pH of 7.8 (i.e. only value that is within the disclosed range of Weinberg et al). Furthermore, these tests are restricted to using silica sol (10 parts by weight of solids content) relative to 100 parts by weight of solid content of resin emulsion. In addition, given that silica sol, in Weinberg et al, is prepared by a substantially similar process and a pH of 7.0 (i.e. neutral) is taught in the general disclosure, it is the examiner's position that silica sol of Weinberg et al would exhibit electrical conductivity of ≤ 1 mS/cm.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KARUNA P. REDDY whose telephone number is (571)272-6566. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/K. P. R./
Examiner, Art Unit 1796

/Vasu Jagannathan/
Supervisory Patent Examiner, Art Unit 1796